

Appl. No. 09/575,858
Reply to Office Action of June 16, 2006

PATENT
450100-02472

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-7 and 9-21 are pending. Claims 1 and 9, which are independent, are hereby amended. Claim 8 has been canceled without prejudice or disclaimer of subject matter. It is submitted that the pending claims, as originally presented, were in full compliance with the requirements 35 U.S.C. §112. No new matter has been introduced by this amendment. Support for this amendment is provided throughout the Specification and specifically on page 95. Changes to claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which the Applicant is entitled.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-7, 9-15, 18, and 19 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,112,101 to Koyama, et al. in view of U.S. Patent No. 6,062,868 to Toriumi, et al.

Claims 16 and 17 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,112,101 to Koyama, et al. in view of U.S. Patent No. 6,062,868 to Toriumi, et al. and further in view of U.S. Patent No. 5,943,102 to Hoshi.

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Koyama is disqualified as §103 prior art to the present application under the provisions of 35 U.S.C. §103(c). Under the provisions of 35 U.S.C. §103(c), subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of 35 U.S.C. §102, shall not preclude patentability under §103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person or organization.

More specifically, M.P.E.P. §2146 states:

These changes to 35 U.S.C. 103(c) apply to all patents (including reissue patents) granted on or after December 10, 2004. The amendment to 35 U.S.C. 103(c) made by the AIPA to change "subsection (f) or (g)" to "one or more of subsections (e), (f), or (g)" applies to applications filed on or after November 29, 1999. It is to be noted that, for all applications (including reissue applications), if the application is pending on or after December 10, 2004, the 2004 changes to 35 U.S.C. 103(c), which effectively include the 1999 changes, apply; thus, the November 29, 1999 date of the prior revision to 35 U.S.C. 103(c) is no longer relevant. (Emphasis added)

Koyama and the present application were, at the time the present invention was made, subject to an obligation of assignment to the same organization, i.e., Sony Corporation. Such obligation is evidenced by the recording of assignment documents in the U.S. Patent and Trademark Office.

Accordingly, Koyama is disqualified as prior art in a rejection under 35 U.S.C. §103(a); and thus all of the outstanding rejections based upon Koyama in the above-noted Office Action are overcome.

However, Applicants note that Koyama is a continuation of application No. 08/637,661 filed on April 29, 1996.

Claim 1 recites, *inter alia*:

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“...index picture generating means for retrieving a picture frame from the contents data, and generating an index picture corresponding to the television system of the record medium so that index pictures generated from contents data having different television systems have the same picture size...”

...wherein index pictures generated from contents data having different television systems can be displayed together in respective picture frames having the same picture frame size.” (emphasis added)

As understood by Applicant, U.S. Patent No. 6,112,101 to Koyama, et al.

(hereinafter merely “Koyama”) relates to forming picture information of intermediate resolution and picture information of low resolution on the basis of high resolution picture information read out from frame memory.

As understood by Applicant, U.S. Patent No. 6,062,868 to Toriumi, et al.

(hereinafter, merely “Toriumi”) relates to a sing-along data system including transmitting method for providing background video data and music and providing a plurality of sing-along receiving terminals for receiving the background video and music.

Applicant submits nothing has been found in Koyama or Toriumi, taken alone or in combination that would teach or suggest the above-identified features of claim 1. Specifically, Applicants submit that Koyama and Toriumi fail to teach index picture generating means for retrieving a picture frame from the contents data, and generating an index picture corresponding to the television system of the record medium so that index pictures generated from contents data having different television systems have the same picture size, and that index pictures generated from contents data having different television systems can be displayed together in respective picture frames having the same picture frame size, as recited in claim 1.

Therefore, Claim 1 is patentable.

For reasons similar to recited above, claim 9 is also patentable.

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III. DEPENDENT CLAIMS

The other claims in this application are each dependent from the independent claim discussed above and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION


In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

Respectfully submitted,

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